

REMARKS/ARGUMENTS

The examiner is thanked for the performance of a thorough search. By this amendment, Claims 16, 42, and 45 have been amended. No claims have been cancelled or added. Hence, Claims 16, 18, 40, and 42-47 are pending in the application. The amendments to the claims as indicated herein do not add any new matter to this application. Each issue raised in the Office Action mailed September 15, 2009 is addressed hereinafter.

I. ISSUES NOT RELATING TO CITED ART—TELEPHONE INTERVIEW

The examiner is further thanked for the telephone interview of December 10, 2009, in which aspects of Claim 1 were discussed in light of the cited art. Furthermore, the combination of references was also discussed.

II. ISSUES RELATING TO CITED ART—CLAIMS 16, 18, 40, AND 42-47

Claims 16, 18, 40, and 42-47 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No, 6,473,903 to Balakrishnan, et al. (“Balakrishnan”) in view of U.S. Patent No, 6,072,982 to Haddad, et al. (“Haddad”) and U.S. Patent No, 5,974,218 to Nagasaka, et al. (“Nagasaka”). The rejection is respectfully traversed.

Claim 16 recites, in part, “while displaying the menu, pausing playback of the program segment by the DVR and the user is allowed to select between skipping past the menu to continue viewing the program segment and selecting a particular item in the menu.” The Office Action cites the combination of Balakrishnan with Haddad, col. 12, lines 44-56 and col. 14, lines 15-26, and Nagasaka col. 1, lines 19-29, col. 18, lines 10-25, and Fig. 5 as allegedly teaching this feature of Claim 16. This is incorrect.

The system of Balakrishnan allows the user to choose to view a particular commercial of the available commercials in a particular commercial interruption. Specifically, Balakrishnan describes:

A system for implementing an interactive broadcast program which includes a transmitter for transmitting a multiplexed data stream which includes a main program and a plurality of different commercials, and a receiver (e.g., a digital television receiver) configured to receive the multiplexed data stream. The receiver includes a display device (e.g., a television monitor) and, facilities responsive to a user action for causing the display device to display a selected one of the plurality of different commercials during a commercial interruption in the main program. (Balakrishnan Abstract, emphasis added.)

To facilitate the user in choosing a commercial, the invention of Balakrishnan provides a menu that represents each commercial that is available in a particular commercial break.

Balakrishnan, col. 3, lines 40-45 indicates that:

at the time of a commercial break in the main program being broadcast over the broadcast channel which is currently selected by the viewer, a choice (or menu) of different commercials which are available to the viewer will be displayed. For example, several different logos or video sequences can be displayed on different portions or spatial locations of the display area of the television screen. The logos or video sequences are representative or indicative of the different products and/or services and/or companies corresponding to the different commercials which are available for display. (Emphasis added.)

Nagasaka describes detecting frames of a recorded program that are indicative of inter-shot transitions in the program, which are taken to be “shot-representative pictures”. (See Nagasaka Abstract.) The Abstract of Nagasaka further indicates as follows:

In a digest picture display, the shot-representative pictures are displayed in a temporally sequential order in which they were generated in such a form that a predetermined number of shot-representative pictures are displayed in each of predetermined time zones in a uniform array, for facilitating comprehension of the contents of the television picture as recorded. Additionally, by selecting one of the shot-representative pictures being displayed a temporal position of the television picture from which reproduction is to be started can visually be determined.

A digest picture display is summoned “[w]hen the user inputs a signal commanding display of a digest list picture in the state of the video recording/reproducing apparatus in which a recording

medium having a video recorded thereof has been loaded and when the digest making apparatus detects the list display command signal (step 1403).” (Nagasaka col. 7, lines 60-66.) Thus, a digest picture display is displayed **in response to a user command**.

Nagasaka col. 18, lines 10-25 further indicates that

in the course of reproduction of a television program as recorded, a relevant digest picture may be displayed to thereby allow the user to select a given shot-representative picture from the digest picture so that the television program can be skipped to the scene represented by the shot-representative picture as selected. In this conjunction, when a command for display of a digest picture is inputted, position-information of the frame being reproduced at that time point may be made use of for omitting the shot-representative pictures which precede to a broadcast time corresponding to the position information mentioned above. Thus, skipping or omission of unwanted video portions such as those of commercial intervals can be much facilitated. (Emphasis added.)

The Office Action alleges that Nagasaka shows “the video recorder will generate a menu for the user to allow selection of a particular commercial within the program or to skip past the commercial break to continue viewing the program.” (See Office Action, page 4, lines 8-10.) However, Claim 16 recites that “the user is allowed **to select between** skipping past the menu to continue viewing the program segment and selecting a particular item in the menu.”

Nothing in Nagasaka suggests that a viewer is presented with a choice as recited in Claim 16. In fact, Nagasaka shows only that a user can command that the digest picture be displayed and then select “a given shot-representative picture from the digest picture so that the television program can be skipped to the scene represented by the shot-representative picture as selected.” (Nagasaka col. 18, lines 10-25.) The ability of a user to skip portions of a recorded program described in Nagasaka is not analogous to allowing a user “to **select between** skipping past the menu to continue viewing the program segment and selecting a particular item in the menu” as recited by Claim 16.

The Office Action admits that Balakrishnan fails to teach or suggest “the user is allowed to select between skipping past the menu to continue viewing the program segment and selecting a particular item in the menu” recited by Claim 16, and does not even allege that Haddad describes this feature.

During the interview of December 10, 2009, the examiner interpreted Balakrishnan as describing providing options to the user. Indeed, Balakrishnan contemplates allowing the user a choice of commercials, and displays the commercial of the user’s choice. However, Balakrishnan does not teach or suggest skipping commercials in any way. In fact, Balakrishnan (col. 3 line 66 – col. 4, line 9) emphasizes that the choice **is only between commercials** by stating:

The viewer can suitably use a remote control unit (RCU) or other user control device (e.g., programmable keypad) to select the commercial he/she desires to view, e.g., by moving a cursor (“pointing”) and clicking on the multimedia hotspot that represents the commercial he/she desires to view, or by entering a program number corresponding to the position of the multimedia hotspot that represents the commercial he/she desires to view. The application program could be written to force the display of a default commercial in the event the viewer does not select any commercial within a predetermined default period of time (e.g., 15-30 seconds). (Emphasis added.)

Thus, Balakrishnan does not teach or suggest giving the user the option to skip a commercial interruption. The choice given to the user is merely which commercial of the available commercials in a commercial interruption to view.

In the above-mentioned interview, the Examiner further interpreted the menu of Balakrishnan, which includes multimedia hotspots corresponding to the commercials that are available in the commercial break, combined with the capability of Nagasaka to skip to any portion of a recorded program as allegedly teaching “the user is allowed to select between skipping past the menu to continue viewing the program segment and selecting a particular item in the menu” recited by Claim 16.

The Applicants respectfully note that the prior art must be considered as a whole. *W.L. Gore & Associates v. Garlock*, 721 F.2d 1540, 1550 (Fed Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). “It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” *In Re Hedges*, 783 F.2d 1038, 1041 (Fed. Cir. 1986). See MPEP 2141.02, Section VI.

The features of Nagasaka are incompatible with the features of Balakrishnan. The combination of Balakrishnan and Nagasaka would destroy the functionality of Balakrishnan. Specifically, it is untenable to assert that Balakrishnan could maintain the functionality of **causing the user to choose one commercial of a plurality of available commercials** if the menu of Balakrishnan were called up in response to user command, as described by Nagasaka. Also, the description in Balakrishnan of automatically forcing display of a default commercial after a certain period of time if the user does not select a commercial would be illogical if the menu were called up upon a user’s command, as described in Nagasaka, because forcing display of a default commercial is only logical at the time of a commercial break. Further, there is no evidence that the invention described in Nagasaka has any ability to automatically pull up a digest picture display at the time of a commercial break, as described in Balakrishnan. Rather, Nagasaka shows that the digest picture display is displayed upon a user request and “in the course of reproduction of a television program as recorded”. (See Nagasaka, col. 18, lines 13-14.)

Claims 42 and 45 recite features that are substantially similar to the features of Claim 16, and are patentable over the cited art for at least the same reasons as Claim 16. Claims 18, 40, 43-44, and 46-47 each depend from one of Claims 16, 42, and 45, and are patentable over Balakrishnan, Haddad, and Nagasaka for at least the same reasons as those discussed in

connection with Claim 16. As is discussed above, Claims 16, 42, and 45 recite features that Balakrishnan, Haddad, and Nagasaka do not disclose. Therefore, Claims 18, 40, 43-44, and 46-47, which inherit these features, are patentable over Balakrishnan, Haddad, and Nagasaka, even when taken in combination under 35 U.S.C. § 103(a). Reconsideration is respectfully requested.

III. CONCLUSIONS & MISCELLANEOUS

For the reasons set forth above, all of the pending claims are now in condition for allowance. The Examiner is respectfully requested to contact the undersigned by telephone relating to any issue that would advance examination of the present application.

A petition for extension of time, to the extent necessary to make this reply timely filed, is hereby made. If applicable, please charge our deposit account for the petition for extension of time fee. If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to charge any applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,

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